

REMARKS

Claims 10-18 are pending and under consideration.

ITEM 2: REJECTION OF CLAIMS 10, 14, 15, and 18 FOR OBVIOUSNESS UNDER 35 U.S.C. §103 BY SHAFFER ET AL. (U.S.P. 5,821,936) IN VIEW OF SAWADA TORU (J. P. APPLICATION 09297214- ABSTRACT)

Claims 10, 14, 15 and 18 are rejected under 35 U.S.C. §103 by Shaffer in view of Sawada Toru.

According to an aspect of the present invention a user of an electronic device is specifically encouraged to utilize a function(s) that the user has not previously utilized. In a case of a decreased frequency of use of a function, a specific reference to an advantage of the function is given. (See, for example, paragraph [0012]). According to aspects of the invention a reference text , which corresponds to a use of supplementary or selection functions, is output based on a trend evaluation of usage. Thus, available resources of the electronic device are not forgotten by the user, and the electronic device can be operated in a more effective manner.

Neither Shaffer nor Sawada Toru teach or suggest features recited in the present application claims including addressing the problem of infrequently used functions. Shaffer only teaches or suggests (col. 2, lines 13-16) rearranging with "most often selected option being presented first." Sawada Toru only teaches (Problem To Be Solved) or suggests displaying a new screen when a frequency of use "exceeds a predetermined specific frequency."

Traverse Of The Rejection

***Prima Facie* Obviousness Not Established**

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F. 2d 1981, (CCPA 1974).

Detection Of Each Activation Of Selection Function Not Taught by Cited Art Alone Or In Combination

Independent claim 10 recites a method for operating an electronic device including "detecting each activation of a predetermined supplementary or selection function." Independent claim 15 recites an electronic device including "a supplementary function detection unit to detect each activation of a particular supplementary or selection function and to produce a detection output."

The Examiner contends these features are taught by Shaffer et al. (Action at page 2 and page 3). However, Shaffer does not teach or suggest a detection of each activation in the lines cited by the Examiner (col. 3, lines 42-55) but only:

(s)election may be made by depression of a second push control . . . other input mechanisms may be substituted. Selection may be provided by depression of the number "2" key 32.

Applicant respectfully submits that nothing in these lines teaches or suggests detecting each activation of a predetermined supplementary or selection function or a supplementary function detection unit to detect each activation of a particular supplementary or selection function and to produce a detection output.

Evaluating Result Of Detecting Using Predetermined Evaluation For Determining At Least One Of Infrequently Used Supplementary And Selection Functions And Outputting Reference Text Corresponding Based On Evaluating Not Taught by Cited Art Alone Or In Combination

Output Of Corresponding Advisory Text For Each Infrequently Used Supplementary Or Selection Function Based On Evaluation Output Evaluating Not Taught by Cited Art Alone Or In Combination

Independent claim 10 further recites a method "evaluating a result of said detecting using a predetermined evaluation for determining at least one of infrequently used supplementary; and selection functions, and outputting reference text corresponding to the at least one of infrequently used supplementary and selection functions based on the evaluating."

Independent claim 15 recites electronic device including "an evaluation unit, coupled to said supplementary function detection unit and said timer, to produce an evaluation output, a user information memory, coupled to said output unit, to store at least one advisory text for at least one infrequently used supplementary or selection function; and a memory control unit, coupled to said evaluation unit and said user information memory, to address said user information memory for output of a corresponding advisory text for each infrequently used supplementary or selection function, based on the evaluation output."

The Action concedes that Shaffer does not teach outputting reference text corresponding to the at least one of infrequently used selection functions based on the evaluating. (Action at page 2).

Nevertheless, the Examiner contends that since Toru teaches:

. . . outputting reference text ("displays to the user a message") indicating that total value of use-frequencies exceeds a threshold (see Abstract). It would have been obvious . . . to modify Shaffer's system to outputting reference text on the display representation along with resequencing the order of menu items in order to introduce and explain to (a) user (of) infrequently used functions or used-frequencies exceeds a threshold.

(Action at pages 2-3, emphasis added).

The Examiner rejects claim 15 "for the same reasons as discussed above with respect to claims 10-11." (Action at page 3).

Even if the Examiner's contention is *arugendo* correct, Applicant submits that Shaffer, Toru, and the Examiner's contention do not teach or suggest outputting reference text corresponding to the at least one of infrequently used supplementary and selection functions based on an evaluating.

No Motivation Or Reasonable Expectation of Success Stated Within the Cited Art To Combine In The Manner Proposed By The Examiner

Applicant respectfully submits that the Examiner is improperly piecing together parts of cited art to show features of the present invention. In addition, Applicant submits there is no motivation stated within Shaffer to modify a method for sequencing display menu items in a manner suggested by the Examiner. Further, the Examiner's contention does not provide any motivation satisfying the standards of *prima facie* obviousness necessary to support the combination of prior art references, as set forth in the attached USPTO Memorandum of Stephen G. Kunin dated February 21, 2002.

Features Of Dependent Claims Not Taught by Cited Art Alone Or In Combination

In addition, features of the dependent claims are not taught by the cited art alone or in combination.

For example, dependent claim 14 recites the method includes "evaluating includes comparing a predetermined reference value with at least one of frequency of activation, the trend determined and the period determined." Dependent claim 18 recites the electronic device includes "a comparator unit, having an input coupled to said reference value memory and an output coupled to said memory control unit, to compare the quantity characterizing the number of activations to the predetermined period and to output a control signal to said memory control unit."

The Examiner contends that Shaffer et al. teaches "comparing a predetermined reference value with the frequency of activation." (Action at page 3). Applicant submits that Shaffer does not teach a comparing, or a comparator unit, but merely (col. 4, lines 18-21):

original, or default index is shown in column 44, while a frequency-based index is shown at column 46.

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 10, 14, 15, and 18 allowed.

ITEM 3: REJECTION OF CLAIMS 11, 13, 16-17 FOR OBVIOUSNESS UNDER 35 U.S.C. §103 BY SHAFFER IN VIEW OF SAWADA TORU AND FURTHER IN VIEW OF COULOMBE (U.S.P. 5,561,753)

Dependent claim 11 recites "evaluating includes determining a frequency of activation of

at least one of infrequently used supplementary and selection functions in a predetermined period." Dependent claim 16 recites the electronic device includes "a counter to detect the number of activations of the particular supplementary or selection function; and an arithmetic calculating unit, coupled to said counter and said timer, to determine a frequency of activation of the particular supplementary or selection function in the predetermined period."

Dependent claim 13 recites the "evaluating includes determining a period which has elapsed since a most recent activation of the at least one of infrequently used supplementary and selection functions." Dependent claim 17 recites the evaluation unit includes a last activation memory to store a last activation time of a particular supplementary or selection function and a subtraction stage, connected to the last activation memory and to said timer, to determine a period which has elapsed since the last activation time.

Regarding claims 11 and 16, the Action concedes that Shaffer does not teach evaluating includes determining a frequency of activation of the at least one of infrequently used functions in a predetermined period. (Action at page 3).

Nevertheless, the Examiner contends that Coulombe teaches:

determining infrequently used functions in a predetermined period . . . It would have been obvious . . . to modify Shaffer's system to determine infrequently used functions in a predetermined period in order to improve the monitoring process.

(Action at page 3).

Regarding claims 13 and 17, the Examiner contends only that Coulombe teaches determining a period that has elapsed since a most recent activation of the infrequently used functions. (Action at page 4).

***Prima Facie* Obviousness Not Established**

No Motivation Or Reasonable Expectation of Success Stated Within the Cited Art To Combine In The Manner Proposed By The Examiner

Applicant submits there is no motivation stated within Shaffer to modify a method for sequencing display menu items with a method for "relocating selectable graphical objects in a graphical user interface" as taught by Coulombe in a manner suggested by the Examiner. Applicant submits the Examiner's contention does not provide any motivation satisfying the standards of *prima facie* obviousness necessary to support the combination of prior art references, as set forth in the attached USPTO Memorandum.

No Motivation Or Reasonable Expectation of Success Stated Within the Cited Art To Combine The Art

Regarding claims 13 and 17, Applicant submits there is no motivation at all to combine Shaffer's sequencing with the relocating as taught by Coulombe, and the Examiner has not

provided any motivation whatsoever.

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 11, 13, and 16-17 allowed.

ITEM 3: REJECTION OF CLAIM 12 FOR UNDER 35 U.S.C. §103 BY SHAFFER IN VIEW OF SAWADA TORU AND FURTHER IN VIEW OF COULOMBE

Dependent claim 12 recites "evaluating includes determining a trend of the frequency of activation in the predetermined period."

***Prima Facie* Obviousness Not Established**

Determining Trend Of Frequency Of Activation Not Taught by Cited Art Alone Or In Combination

The Examiner contends that Coulombe teaches "determining a trend of the frequency of activation in the predetermined period (col. 5, lines 14-21)." (Action at page 4).

Applicant respectfully submits that the Examiner's contention is not correct and Coulombe does not teach a trend, but merely (col. 5, lines 13-15) "duration of access criterion."

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claim 12 allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: February 21, 2002

To: Patent Examining Corps
Technology Center Directors

From: Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

Subject: Procedures for Relying on Facts Which are Not of Record as
Common Knowledge or for Taking Official Notice

This memorandum clarifies the circumstances in which it is appropriate to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection.

Recent court decisions have affected the Office's practice of taking official notice of facts by relying on common knowledge in the art without a reference. Specifically, the Supreme Court recently changed the standard of review applied to decisions of the Board of Patent Appeals and Interferences and the Trademark Trial and Appeal Board on appeal to the U.S. Court of Appeals for the Federal Circuit. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). As a result, the Federal Circuit now reviews findings of fact under the "substantial evidence" standard under the Administrative Procedure Act (APA), rather than the former "clearly erroneous" standard. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).¹ This change in the review standard has affected the Federal Circuit's view of when the court or the USPTO may take notice of facts without specific documentary evidence support.²

On remand from the Supreme Court, the Federal Circuit in *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), reversed the Board's decision upholding a rejection under 35 U.S.C. 103 for lack of substantial evidence. Specifically, in *Zurko* and other recent decisions, the court criticized the USPTO's reliance on "basic knowledge" or "common sense" to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.³ In light of the recent Federal Circuit decisions and the substantial evidence standard of review now applied to USPTO Board decisions, the following guidance is provided in order to assist the examiners in determining when it is appropriate to take official notice of facts without

supporting documentary evidence or to rely on common knowledge in the art in making a rejection, and if such official notice is taken, what evidence is necessary to support the examiner's conclusion of common knowledge in the art.

(1) Determine when it is appropriate to take official notice without documentary evidence to support the examiner's conclusion.

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, as noted in MPEP § 2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.⁴ In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection.⁵

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.⁶

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.⁷ As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.⁸

(2) If official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge.⁹ In certain older cases, official notice has been taken of a fact that is asserted to be "common knowledge" without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there

was nothing of record to contradict it.¹⁰ If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.¹¹ The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

(3) If applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.¹² A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.¹³ If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

(4) Determine whether the next Office action should be made final.

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly cited reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. See MPEP § 706.07(a).

(5) Summary.

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.¹⁴

MPEP § 2144.03 will be revised accordingly in the upcoming revision to be consistent with this memo.

Cc: Nicholas Godici
Esther Kepplinger
Kay Kim
David Lacey

¹ The Supreme Court has described substantial evidence review in the following manner:

Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion...Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229-30 (1938)(quoted in *Gartside*, 203 F.3d at 1312, 53 USPQ2d at 1773). "'Substantial evidence' review involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency's decision." *Gartside*, 203 F.3d at 1312, 53 USPQ2d at 1773 (citing *Universal Camera Corp. v. NLRB*, 340 U.S. 474, 487-88 (1951)). Furthermore, the Supreme Court has also recognized that "the possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence." *Consolo v. Federal Maritime Comm'n*, 383 U.S. 607, 620 (1966) (quoted in *Gartside*, 203 F.3d at 1312, 53 USPQ2d at 1773).

² See *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1360, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) (questioning authority to take judicial notice for the first time on appeal in light of the APA standard of review established by *Dickinson v. Zurko*, 527 U.S. at 165, 50 USPQ2d at 1937). Although the substantial evidence standard is deferential to the agency's decision, it imposes certain evidentiary requirements that must be met by the agency in formulating a decision. The Federal Circuit explained that "[i]n appeals from the Board, we have before us a comprehensive record that contains the arguments and evidence presented by the parties, including all of the relevant information upon which the board relied in rendering its decision." *Gartside*, 203 F.3d at 1314, 53 USPQ2d at 1774. Furthermore, the record is "closed, in that the Board's decision must be justified within the four corners of that record." *Id.* Thus, the record before the USPTO "dictates the parameters of review" available to the court. *Id.* Accordingly, "the Board's opinion must explicate its factual conclusions, enabling [the court] to verify readily whether those conclusions are indeed supported by 'substantial evidence' contained within the record." *Id.* (citing *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997)).

³ *Zurko*, 258 F.3d at 1385, 59 USPQ2d 1697 ("the Board cannot simply reach conclusion based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). See also *In re Lee*, ___F.3d___, ___, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (The Board determined that it was not necessary to present a source of a teaching, suggestion, or motivation to combine the references

because the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art. The court reversed the Board's decision in sustaining a rejection under 35 U.S.C. 103 and stated that "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation...The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies").

⁴ As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471, F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it").

⁵ *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697; *In re Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

⁶ *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[w]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

⁷ *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it make clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issue." *Id.* at 1385-86, 59 USPQ2d at 1697.

⁸ *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. See also *In re Lee*, ___ F.3d at ___, 61 USPQ2d at 1435.

⁹ See *In re Lee*, ___ F.3d at ___, 61 USPQ2d 1434-35; *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

¹⁰ See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963) (the court accepted the examiner's assertion that the use of "a control is standard procedure throughout the entire field of bacteriology" because it was readily verifiable and disclosed in references of record not cited by the Office); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (accepting examiner's finding that a brief heating at a higher temperature was the equivalent of a longer heating at a lower temperature where there was nothing in the record to indicate the contrary and where the applicant never demanded that the examiner produce evidence to support his statement).

¹¹ See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.

¹² See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

¹³ See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("the Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test).

¹⁴ See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.